

## REMARKS

### Status of the Claims

Upon entry of the amendment above, claims 2-13, 15, 17-20, 24-27, 29, 30, and 33-35 will be pending, *claim 24 being the only independent claim*. All but claims 19 and 20 are "readable" on the elected invention.

### Summary of the Office Action

Claims 19 and 20 stand withdrawn from consideration as being directed to an embodiment of the invention that was non-elected in response to the Examiner's previously imposed restriction requirement.

Claims 1-18, 24-27, and 29-32 stand rejected under 35 USC §103(a) as being unpatentable over HOSHIZAKI et al. (U.S. Patent No. 5,498,033, hereinafter "HOSHIZAKI") in view of BOURDEAU (U.S. Patent No. 5,887,886).

### Response to the Office Action

#### A. Interview With Examiner Mohandesi, Summary of Amendment, and Request for Entry of Amendment

First, Applicant's undersigned representative wishes to thank Examiner Mohandesi for her agreement to schedule an interview on April 3, 2003, despite the finality of the Office action.

By means of the interview, Applicant's representative became more clearly informed of the Examiner's positions regarding the various forms of claims that had been pending prior to the instant amendment (which had included five independent claims).

As a result of the interview and, for the purpose of advancing prosecution of the instant application, perhaps to allowance with the Examiner's reconsideration of the invention in view of the amendment herein, Applicant's undersigned representative has reduced the total number of claims and he has reduced the number of independent claims from five to only one independent claim, viz., claim 24.

Among other limitations, independent claim 24 includes the following features: (a) at least the lateral portion of the flexible frame (such as lateral arm 15 (see, *e.g.*, Fig. 4 or Fig. 7) is spaced above the external sole of the boot of the invention; (b) the lateral portion of the flexible frame is connected to the external sole of the boot of the invention proximate an area of the metatarsophalangeal joint; (c) the flexible frame extends above the ankle region of the boot; and (d) the flexible frame does not extend through a lower surface of the outer sole (*i.e.*, unlike the rigid frame of BOURDEAU).

In addition, claim 24 specifies that the frame is a flexible frame, *i.e.*, one that can be flexed (not a *rigid* frame as in BOURDEAU, nor a frame intending merely *rigidify* the heel of the boot as in HOSHIZAKI).

In a more specific recitation of the invention (not encompassing the embodiment of Figs. 1, 2), new claim 33 further specifies that the dorsal portion of the flexible frame (*i.e.*, in addition to the lateral portion(s)) is spaced above the external sole. New claims 34 and 35 merely specify that the flexible frame is to be external or internal, respectively, of the upper of the boot, as mentioned on page 12, lines 4-5, of the specification of the instant application.

The amendment submitted herein represents a sincere effort to present a set of claims to which Applicant believes that he is entitled, in view of the references of record, yet a set that has been simplified for the benefit of the Examiner's consideration.

Accordingly, Applicant kindly requests that the amendment herein be considered for placing the instant application in condition for allowance. Alternatively, if any issue were to remain outstanding, or if the Examiner were to suggest any necessary amendment for allowance, Applicant's undersigned representative is willing to discuss the application with her.

**B. Withdrawal of Rejection Under 35 USC §103(a) Based Upon HOSHIZAKI and BOURDEAU**

Upon entry of the amendment presented herewith, claim 24 would be the only independent claim. Claims 2-13, 15, 17-20, 24-27, 29, 30, and 33-35 would be pending.

HOSHIZAKI is directed to a skate boot especially used for hockey. The invention of HOSHIZAKI preferably includes an injection molded plastic overlay that is intended to increase the rigidity of the rear of the skate (see column 2, lines 12-16 and 42-44).

BOURDEAU is directed to a sport boot having a sole and an attachment member (elements 31, 32) affixed to the sole against movement with respect to the sole. The boot comprises an upper having a rigid internal skeleton extending from a portion of the sole and upwardly at least along a lateral side of the boot. The skeleton constitutes a minimal energy circuit for the transmission of forces and support, such circuit passing through the attachment means of the boot.

Independent claim 24 is directed to a sports boot that includes an outer sole and an external upper, the upper including a *flexible frame* that made of a substantially *non-stretchable material*. Further, as mentioned above, claim 24 also includes the following features: (a) at least the lateral portion of the flexible frame is spaced above the external sole of the boot of the invention; (b) the lateral portion of the flexible frame is connected to the external sole of the boot of the invention proximate an area of the metatarsophalangeal joint; (c) the flexible frame extends above the ankle region of the boot; and (d) the flexible frame does not extend through a lower surface of the outer sole.

Both HOSHIZAKI and BOURDEAU are directed to rigidifying structures. HOSHIZAKI is concerned with rigidifying the rear of the boot, from the heel to ankle region thereof (see column 1, lines 36-37). HOSHIZAKI's invention is directed to a rigidifying, preferably molded plastic, overlay for the heel of a skate. Applicant submits that the plastic overlay of HOSHIZAKI does not extend above the ankle region of the skate; instead, the overlay is *in* the ankle region. In HOSHIZAKI, it is important to allow plantar flexion (column 1, lines 31-33) and it would not appear that extending the plastic overlay upwardly further than disclosed by HOSHIZAKI would be consistent with that objective.

Therefore, Applicant would submit that one skilled in the art would not consider modifying the height of the frame of HOSHIZAKI, by means of a teaching from BOURDEAU or otherwise.

Further, Applicant's dependent claim 13 additionally specifies, with regard to the boot defined in parent claim 24, and with regard to the height of the flexible frame, that the flexible frame extends above the ankle region to about a middle region of a tibia of the user.

Panels 7 of HOSHIZAKI's plastic overlay are at the *rear*, not at the metatarsophalangeal joint, as specified in Applicant's claim 24. This difference is more than a mere obvious matter of design. The location of the lateral portion of the flexible frame according to Applicant's invention is important for an optimum transmission of the forces that are generated during use of the boot, as explained by Applicant on page 6, lines 11-13, of the specification, for example.

In addition to the foregoing, claim 24 specifies that the frame is a flexible frame, *i.e.*, one that can be flexed (not a *rigid* frame as in BOURDEAU, nor a frame intending to merely *rigidify* the heel of the boot as in HOSHIZAKI).

Still further, for the boot of the invention, or with the boot of HOSHIZAKI, with no attachment means like that of BOURDEAU, there would have been no need to use the skeleton of BOURDEAU.

In addition, with no skeleton, there would have been no suggestion to one skilled in the art to have made the dorsal part of the plastic overlay of HOSHIZAKI higher in view of BOURDEAU.

Further, with regard to dependent claim 33, whereby the dorsal portion of the flexible frame of the invention is spaced above the outer sole, and with regard to the wide scallop 44 of BOURDEAU, the same is a part of a shell 41 which is rigid, whereas, very differently in the invention, the frame is flexible. An elimination of the bottom of the plastic overlay of HOSHIZAKI, in view of such disclosure of BOURDEAU, the objective of HOSHIZAKI's rigid plastic overlay would appear to be compromised and, therefore, such modification would not

have been obvious.

Still further, portions 31 of the rigid frame of BOURDEAU extend through the outer sole for the purpose of providing a connection to a snowboard. Such feature would not be necessary for HOSHIZAKI and, therefore, the combination would be at odds with HOSHIZAKI's disclosure. Further, Applicant's claim 24 specifies that the flexible frame does *not* extend through the outer sole.

At least for the foregoing reasons, Applicant submits that the combination of HOSHIZAKI and BOURDEAU would not have been made by one skilled in the art except for the suggestion provided by Applicant's disclosure. Accordingly, reconsideration and withdrawal of the rejection based upon HOSHIZAKI and BOURDEAU is requested.

In addition to various features/limitations in Applicant's claim 24 and dependent claim 33, the remaining dependent claims add additional limitations that patentably distinguish the invention specified therein from the documents of record.

#### **SUMMARY AND CONCLUSION**

Entry of the amendment above is kindly requested. The amendment simplifies issues and advances prosecution of the instant application. The total number of claims has been reduced and the number of independent claims has been reduced to one.

The sole ground of rejection advanced in the Office action has been addressed and is believed to be overcome. Reconsideration and allowance are respectfully requested in view of the amendment and remarks above.

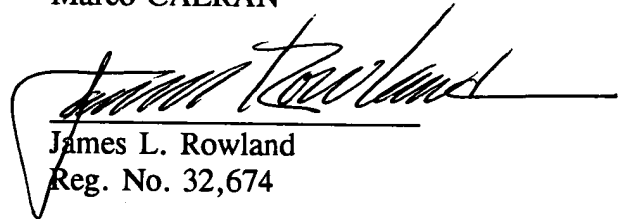
Any amendment to the claims presented above, which has not been specifically noted to overcome a rejection based upon prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach to such amendments.

A check is attached for payment of a fee for a one month extension of time. No additional fee is believed to be due at this time. However, the Commissioner is authorized to

charge any fee required for acceptance of this reply as timely and complete to Deposit Account No. 19-0089.

Any comments or questions concerning this application can be directed to the undersigned at the telephone or fax number given below.

Respectfully submitted,  
Marco CAERAN



James L. Rowland  
Reg. No. 32,674

April 16, 2003  
GREENBLUM & BERNSTEIN, P.L.C.  
1950 Roland Clarke Place  
Reston, VA 20191

(703) 716-1191 (telephone)  
(703) 716-1180 (fax)